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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,936	04/28/2005	Tatsuo Sudoh	0033.0996PUS1	3091
2292 7590 01/05/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER DASGUPTA, SOUMYA				
ART UNIT		PAPER NUMBER		
2176				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/532,936

**Applicant(s)**

SUDOH ET AL.

**Examiner**

SOU MYA DASGUPTA

**Art Unit**

2176

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-912)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Applicant's Response***

In the applicant's response for application 10/532,936 dated November 23, 2010, the applicant did not amend any claims and argued against all the rejections and objections. The application is a 371 of PCT/JP03/15824 dated 12/10/2003. The Assignee is Sharp.

Claims 61-66 are currently pending and have been considered below. Claim 61 is an independent claim.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

*Claims 61-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.*

**Claims 61:**

In summary, Claim 61 recites a "*recording medium*" storing instructions that perform various functions. In the Specification of the present application, the "*recording medium*" is expressly defined as including transmission media (see Page 76, Line 18 - Page 7, Line 20). Thus, the recited "*recording medium*" is not a "process," a "machine," a "manufacture" or a "composition of matter," as defined in 35 U.S.C. 101.

Accordingly, Claim 61 fails to recite statutory subject matter under 35 U.S.C. 101.

Claims 62-66 merely recites either additional functions performed by the instructions or additional descriptions of electronic data. Accordingly, Claims 62-66 fail to recite statutory subject matter under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

*Claims 61-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ching et al (US 7,260,785; Patent Issue Date: Aug 21, 2007; Patent Filing Date: Jan 29, 2001; Assignee: IBM; hereafter Ching) in view of Ohba (US 2002/0120701; PG Pub Date: Aug 29, 2002; Patent Filing Date: Feb 14, 2002; Assignee: Sony; hereafter Ohba).*

**Claim 61:**

Ching discloses:

**a recording medium recording multimedia contents data having a data structure, which is processed in a data processing device that includes a reproducing unit for reproducing media data and an inputting unit for receiving an input operation from a user, and which includes:** (pre-amble) (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that the system transmits and broadcasts video to remote audiences. Ching discloses "reproducing media data" in that the national broadcasters send video to the remote audiences. Ching discloses "input operation from a user" in that local stations can manually input with respect to certain time slots.)

**a reproduction describing unit for showing media data that is reproduced in said reproducing unit of said data processing device;** (limitation 1) (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that an audience can see the media data on their television sets.)

**an input operation describing unit for showing an input operation that is received by said inputting unit of said data processing device and a process that corresponds to said input operation;** (limitation 2) (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations can manually input with respect to certain time slots. The broadcasters may choose to have the program

stream sent via terrestrial links (ethernet, token ring, etc.) while the spot insertion is sent via satellites or vice versa.)

**and a schedule describing unit for managing time of effect of said media data that is reproduced in said reproducing unit of said data processing device and time of effect of said input operation that is received by said input unit,** (limitation 3)

(Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations can manually input with respect to certain time slots. A zone, defined by cable or network operators in an area, sells a commercial in the local availability time. All receivers that are within the zone air local spots for that zone at that scheduled time.)

**wherein said multimedia contents data is processed so that predetermined media data is reproduced in said reproducing unit of said data processing device at a predetermined time on the basis of said schedule describing unit,** (limitation 4)

(Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations can manually input with respect to certain time slots. A zone, defined by cable or network operators in an area, sells a commercial in the local availability time. All receivers that are within the zone air local spots for that zone at that scheduled time.)

**a predetermined input operation is received by said inputting unit of said data processing device at said predetermined time,** (limitation 5) (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations may insert their local ads at an allotted time.)

**and said data processing device carries out a process that corresponds to said predetermined input operation at said predetermined time on the basis of said input operation describing unit.** (limitation 6) (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations may insert their local ads at an allotted time. After the local ads, the system then continues to broadcast national programs.)

Ching does not expressly disclose:

**data is reproduced in said reproducing unit of said data processing device at a predetermined time on the basis of said schedule describing unit,** (limitation 4)  
**a predetermined input operation is received by said inputting unit of said data processing device at said predetermined time,** (limitation 5)

Ching in view of Ohba discloses:

**data is reproduced in said reproducing unit of said data processing device at a predetermined time on the basis of said schedule describing unit,** (limitation 4) (Fig 4, Paragraphs [0065] – [0069] → The system plays contents of a movie and then displays questions to the user at a certain time. The final product is then compiled into an email and sent to another user.)

**a predetermined input operation is received by said inputting unit of said data processing device at said predetermined time,** (limitation 5) (Fig 4, Paragraphs [0065] – [0069] → The system plays contents of a movie and then displays questions to the user at a certain time. The final product is then compiled into an email and sent to another user.)

for the purpose of forming an email as a final presentation product by readily attaching multimedia contents to the email (see Paragraph [0008]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Ching, to include:

**data is reproduced in said reproducing unit of said data processing device at a predetermined time on the basis of said schedule describing unit,**  
(limitation 4)

**a predetermined input operation is received by said inputting unit of said data processing device at said predetermined time,** (limitation 5)

for the purpose of forming an email as a final presentation product by readily attaching multimedia contents to the email, as taught by Ching.



**Claim 62:**

Ching in view of Ohba discloses the limitations of Claim 61.

Ching discloses **wherein said process that corresponds to said input operation received by said input unit of said data processing device is a process for adding a change to said multimedia contents data.** (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations may insert their local ads at an allotted time.)

**Claim 63:**

Ching in view of Ohba discloses the limitations of Claim 62.

Ching discloses **wherein said process for adding said change to said multimedia contents data is a process for replacing a portion of said multimedia contents data.** (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations may insert their local ads at an allotted time. The empty time slots are being replaced with local ads.)

**Claim 64:**

Ching in view of Ohba discloses the limitations of Claim 62.

Ching discloses **wherein said process for adding said change to said multimedia contents data is a process of adding data that is obtained by replacing a portion of said multimedia contents data to said contents data.** (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations may insert their local ads at an allotted time. The empty time slots are being replaced with local ads.)

**Claim 65:**

Ching in view of Ohba discloses the limitations of Claim 62.

Ching discloses **wherein said process for adding said change to said multimedia contents data is a process for adding data that is obtained by replacing a portion of said multimedia contents data in a predetermined subsequent process to said multimedia contents data.** (Abstract; Fig.1; Col 2, Line 54 - Col 3, Line 59 → Ching discloses this limitation in that local stations may insert their local ads at an allotted time. The empty time slots are being replaced with local ads.)

*Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ching et al 9(US 7,260,785; Patent Issue Date: Aug 21, 2007; Patent Filing Date: Jan 29, 2001; Assignee: IBM; hereafter Ching) in view of Ohba (US 2002/0120701; PG Pub Date: Aug 29, 2002; Patent Filing Date: Feb 14, 2002; Assignee: Sony; hereafter Ohba) in further view of Morris et al (US 5,862,372; Patent Issue Date: Jan 19, 1999; Patent Filing Date: Nov 16, 1994; hereafter Morris).*

**Claim 66:**

Ching in view of Ohba disclose the limitations of Claim 61.

Ching in view of Ohba do not expressly disclose:

**wherein said multimedia contents data is data that is described in script language.**

Morris discloses:

**wherein said multimedia contents data is data that is described in script language.**(Figs 3-5; Col 3, lines 28-61 → Morris discloses this limitation in that objects on the GUI are implemented in script language.)

for the purpose of providing "objects [that] can be added or deleted [to and from] the main program with great ease " (see Col 3, Lines 28-61).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Ching in view of Ohba, to include:

**wherein said multimedia contents data is data that is described in script language.**

for the purpose of providing objects that can be added or deleted to and from the main program with great ease, as taught by Ching.

### ***Response to Arguments***

#### **Claim (61-65) Rejection under 35 USC ~ 102(b) - Ching**

The applicant argues that the prior art does not disclose the limitations of Claim 61. More specifically, Ching does not disclose: (i) wherein said multimedia contents data is processed so that predetermined media data is reproduced in said reproducing unit of said data processing device at a predetermined time on the basis of said schedule describing unit, (ii) a predetermined input operation is received by said inputting unit of said data processing device at said predetermined time, (iii) and said data processing device carries out a process that corresponds to said predetermined input operation at said predetermined time on the basis of said input operation describing unit. The applicant also states that Ching does not disclose (iv) a predetermined input operation

is received by said **inputting unit of said data processing device at the same predetermined time.** (emphasis added)

Applicant's arguments with respect to claims 61- 65 have been considered but are moot in view of the new ground(s) of rejection.

Claim (66) Rejection under 35 USC ~ 103(a) – Ching in view of Morris

Claim 66 is a dependent on independent Claim 61; claim 66 (dependent claim) is rejected by Ching in view of Morris because the prior art reads on the claim limitations.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SOUMYA DASGUPTA whose telephone number is (571)272-7432. The examiner can normally be reached on M-Th 9am-7pm, F 9am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Soumya Dasgupta/  
Examiner, Art Unit 2176

/DOUG HUTTON/  
Supervisory Patent Examiner, Art Unit 2176